

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional)  014033-000023									
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____	Application Number  10/709,184	Filed  April 20, 2004									
	First Named Inventor  Gagnon et al.										
	Art Unit  3695	Examiner  Michael D. Cranford									
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%; border: none;"><tr><td style="width: 50%; vertical-align: top; padding-bottom: 10px;"><input type="checkbox"/> applicant/inventor.</td><td style="width: 50%; vertical-align: top; padding-bottom: 10px;">/R. Brian Drozd/ _____ Signature</td></tr><tr><td style="vertical-align: top; padding-bottom: 10px;"><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td style="vertical-align: top; padding-bottom: 10px;">R. Brian Drozd _____ Typed or printed name</td></tr><tr><td style="vertical-align: top; padding-bottom: 10px;"><input checked="" type="checkbox"/> attorney or agent of record. Registration number 55130 _____</td><td style="vertical-align: top; padding-bottom: 10px;">704-331-1033 _____ Telephone number</td></tr><tr><td style="vertical-align: top; padding-bottom: 10px;"><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td style="vertical-align: top; padding-bottom: 10px;">10/08/2010 _____ Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<input type="checkbox"/> applicant/inventor.	/R. Brian Drozd/ _____ Signature	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	R. Brian Drozd _____ Typed or printed name	<input checked="" type="checkbox"/> attorney or agent of record. Registration number 55130 _____	704-331-1033 _____ Telephone number	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	10/08/2010 _____ Date
<input type="checkbox"/> applicant/inventor.	/R. Brian Drozd/ _____ Signature										
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<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	10/08/2010 _____ Date										
<input type="checkbox"/> *Total of _____ forms are submitted.											

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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## **REMARKS IN SUPPORT OF PRE-APPEAL REQUEST FOR REVIEW**

Applicant submits that the current and preceding Office Actions issued by the Office in the present application contain clear errors in the Office's rejections as well as omissions of one or more essential elements needed for a *prima facie* rejection under 35 U.S.C. § 102(b).

### **Final Office Action Rejections**

Claims 1, 5-7, 10, 12-14, 16, 19-36 and 38-39 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent Application Publication No. 2003/0065613 to Smith ("Smith"). Claims 4, 11, 18 and 37 were rejected under 35 U.S.C. § 103 as obvious over Smith in view of "Financial Advisor." Claims 14, 22, 30, 36 and 39 were rejected under 35 U.S.C. § 103 as obvious over Smith in view of U.S. Patent Application Publication No. 2002/0147670 to Lange ("Lange").

### **Legal Precedent**

The basic requirement of a *prima facie* case of anticipation under 35 U.S.C. § 102(b) is that each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. See MPEP § 2131. As discussed below, Smith does not teach or disclose the features of the presently-claimed invention, including the recitations of independent Claims 1, 12, 20, 28 and 34.

### **Claims 1, 5-7, 10, 12-14, 16, 19-36 and 38-39 Are Patentable Over Smith**

Smith is directed to a software application for supervision, regulation, statistical services and credit risk management. Such software application is designed to retrieve financial institution information from a variety of systems, filter that information and deliver it to the appropriate users through a single point of access. The system of Smith provides access to financial institution profiles, tracks institution performance, performs risk assessment and generates alerts.

In contrast, Claim 1 recites:

"A method to manage a credit portfolio and to trigger credit actions, comprising:

reviewing a status of at least one creditor at predetermined time intervals, wherein each of the at least one creditor having an outstanding loan from an entity;

identifying at least one status indicator for a creditor;

selecting the creditor to review;

generating a series of inquiries with reference to the creditor, wherein the series of inquiries comprises a series of questions designed to elicit information related to at least one of the creditor and a status indicator;

presenting the inquiries to a user associated with the entity;

determining a quantity of triggers flagged for the selected creditor based on the responses to the inquiries with reference to the creditor;

determining if a key risk review is necessary for the creditor in response to the quantity of flagged triggers being greater than a predetermined number, wherein the key risk review is determined to be necessary if the selected creditor corresponds to a predetermined loss to the entity in the event the creditor becomes bankrupt; and

conducting a key risk review in response to determining that a key risk review is necessary, wherein the key risk review comprises reviewing actions to reduce exposure or loss.”

In rejecting each of the above-recitations of Claim 1, various portions of Smith were cited. Each of these recitations and the corresponding rejected portion(s) of Smith are discussed below.

First, paragraph [0119] of Smith was cited as teaching “selecting the creditor to review.” Paragraph [0119] of Smith recites:

“[0119] The Headlines Page 102 is advantageously selected as the main entry point to the system. It enables ready access to the factors of the subject invention. From the Headlines Page 102, access to the various modules, views, and databases is provided, the particulars of which will be detailed below. The Headlines Page 102 is fully customizable by each user of the system. As is observed in FIG. 2, the Headlines Page 102 is divided into four main sections. The Navigation Pane 202 is located on the left side of the screen. The Navigation Pane 202 provides Navigation to SuperLink Databases, Web Links, and Other Notes Database Links. The center pane 204 of the Headlines Page 102 is the Push Technology Pane. Pane 204 provides links to alerts, links to news, and discussion monitor. The right pane 206 is the Personal Information Manager pane which is comprised of filtered electronic mail, calendar, events and ToDo's. Across the top of the panes 202, 204, and 206 is an action bar 208. The action bar 208 contains application buttons customizable by each user, a refresh button and a link to the user's profile.”

Applicant can find no discussion in Smith of selecting a creditor, much less selecting a creditor for review. In fact, there is no disclosure of a creditor anywhere in this cited portion of Smith.

Next, the Office Action cited paragraph [0009] of Smith as teaching “generating a series of inquiries with reference to the creditor,” “presenting the inquiries to a user associated with the entity,” and “determining a quantity of triggers flagged for the selected creditor based on the responses to the inquiries with reference to the creditor,” as recited in Claim 1. Paragraph [0009] of Smith recites:

“[0009] The performance database performs corporate and departmental tracking and generates balanced scorecard information. The database uses industry standard perspectives and shows whether objectives are not met, mostly met, met, or exceeded. Measurements and targets are established for each objective. Additionally, goals and the actions performed to meet those goals are tracked at corporate and departmental levels.”

Accordingly, Smith discloses a database that generates scorecard information to show whether objectives are met or not based on measurements and targets for each objective. Yet, there is no discussion in Smith of any “inquiries with reference to a creditor,” much less “generating a series of inquiries with reference to the creditor,” as recited in Claim 1. The scorecard information of Smith does not display any inquiries at all. Additionally, there is also no disclosure in Smith of “presenting the inquiries to a user associated with [an] entity,” as recited in Claim 1, where the entity has an outstanding loan with the creditor. In fact, as mentioned above, Smith does not disclose any inquiries being presented at all, much less being presented to a user associated with the above-described entity. Furthermore, there is no disclosure in Smith of “determining a quantity of triggers flagged for the selected creditor based on the responses to the inquiries with reference to the creditor,” as recited in Claim 1. There is no discussion

in Smith of *any triggers, any determination of triggers that are flagged, or determining any triggers based on responses to the inquiries*. As such, the burden of establishing a *prima facie* case of anticipation has simply not been made.

With regard to the “series of inquires comprises a series of questions designed to elicit information related to at least one of the creditor and a status indicator,” the Office Action cited paragraph [0167] of Smith, which recites:

“[0167] The Discussion Database 130 is discussion database, easily implemented as a standard Lotus Notes Discussion database by use of the platform of the preferred embodiment. This database is used to communicate questions, answers, tips, etc. The Discussion Database 130 may also be used to share knowledge. The database shows discussion thread, such as Main Topic, Response, and Response to Response. Document types stored in the database include Main, Response, and Response to Response. Categories are also used. A user may select an existing category or create a new one. Only the author of a document can update it, all other users only have read access. The Discussion Database 130 facilitates knowledge sharing by providing a common place for comments, collaboration and questions and answers. FIG. 73 is an example of a Discussion By Category view 7300. FIG. 74 is an example of a Discussion Main Topic document 7400.”

Accordingly, Smith discusses the use of a database that is “used to communicate questions, answers, tips, etc.” and allows “discussion threads.” However, there is no discussion in Smith of a “series of inquires [that] comprises a series of questions designed to elicit information related to at least one of the creditor and a status indicator,” as specifically recited in Claim 1. There are no inquires in Smith “generated” and “presented” to a user associated with the entity. The basic requirement of a *prima facie* case of anticipation under 35 U.S.C. §102(b) is that each and every element as set forth in the claim is found in a single prior art reference. *See* MPEP §2131. This burden has not been met by the Office.

The Office Action also paragraph [0004] of the Background section of Smith as disclosing “determining if a key risk review is necessary for the creditor in response to the quantity of flagged triggers being greater than a predetermined number,” and “conducting a key risk review in response to determining that a key risk review is necessary, wherein the key risk review comprises reviewing actions to reduce exposure or loss,” as recited in Claim 1. Paragraph [0004] of Smith recites:

“[0004] The various risk assessments and surveillance of the institution are conducted at varying intervals. Thus a risk factor may become critical during the cycle in between assessments. It is also desired that a system be created whereby alerts may be generated and communicated to the various monitoring groups on a real time basis.”

Accordingly, Smith discloses conducting risk assessments and surveillance of an institution at varying intervals and generating alerts. Yet, Smith does not disclose “determining if a key risk review is necessary.” The risk assessment of Smith happens regardless as to whether the risk assessment is necessary or not. There is no determination of a key risk review in Smith, much less a determination “if a key risk review is necessary for the creditor *in response to* the quantity of flagged triggers being greater than a predetermined number,” as recited in Claim 1. There is no

discussion in Smith of a “quantity” of triggers or such quantity of triggers “being greater than a predetermined number.” Further, there is no disclosure in Smith of “conducting the key risk review *in response to* determining that a key risk review is necessary, wherein the key risk review comprises reviewing actions to reduce exposure or loss,” as recited in Claim 1. Smith only discusses risk assessment generally and does not disclose “reviewing actions to reduce exposure or loss.”

Furthermore, the Office Action cited paragraph [0127] of Smith as disclosing “the key risk review is determined to be necessary if the selected creditor corresponds to a predetermined loss to the entity in the event the creditor becomes bankrupt” of Claim 1. Paragraphs [0126]-[0127] of Smith recite:

“[0126] The Risk database 114 (FIG. 1) is a workflow and reporting application which supports the creation and approval of Risk Assessments. The Risk Assessment Database 114 (FIG. 1) provides a comprehensive method for preparing, reviewing and reporting risk assessments. The risk assessment should highlight both the strengths and vulnerabilities of an institution as well as providing a foundation for determining the supervisory activities to be conducted. Further, the assessment should apply to the entire spectrum of risks facing an institution. Therefore the entire SuperLink Risk Assessment program is driven by the following six risk factors.

[0127] Credit risk, which arises from the potential that a borrower or counter party will fail to perform on an obligation. Market risk, which is the risk to a financial institution's condition resulting from adverse movements in market rates or prices, such as interest rates, foreign exchange rates, or equity prices. Liquidity risk, which is the potential that an institution will be unable to meet its obligations as they come due because of an inability to liquidate assets or obtain adequate funding (referred to as “funding liquidity risk”) or that it cannot easily unwind or offset specific exposures without significantly lowering market prices because of inadequate market depth or market disruptions (“market liquidity risk”). Operational risk, which arises from the potential that inadequate information systems, operational problems, breaches in internal controls, fraud, or unforeseen catastrophes will result in unexpected losses. Legal risk, which arises from the potential that unenforceable contracts, lawsuits, or adverse judgements can disrupt or otherwise negatively affect the operations or condition of a banking organization. Reputational risk, which is the potential that negative publicity regarding an institution's business practices, whether true or not, will cause a decline in the customer base, costly litigation, or revenue reductions.”

Accordingly, Smith discloses that the risk assessment program is driven by six risk factors: credit risk, market risk, liquidity risk, operational risk, legal risk and reputational risk. However, there is no disclosure in Smith that a “key risk review is determined to be necessary if the selected creditor corresponds to a predetermined loss to the entity in the event the creditor becomes bankrupt,” as recited in Claim 1. There is no discussion in Smith when a key risk review is determined to be necessary, much less determining if the key risk review is necessary *if the selected creditor corresponds to a predetermined loss in the event of the creditor becoming bankrupt*. In fact, neither the term “bankrupt” nor the concept of bankruptcy is mentioned or discussed in Smith.

In light of the above it is submitted that independent Claim 1, as well as the claims dependent therefrom, are patentable over Smith. Reconsideration and withdrawal of the 35 U.S.C. § 102 rejection of Claims 1, 5-7 and 10 are respectfully requested. Independent Claims 12, 20, 28 and 34, as well as the claims dependent therefrom, are

patentable over Smith for the same reasons as discussed above with respect to Claim 1, and Applicant respectfully solicits reconsideration and withdrawal of the 35 U.S.C. § 102 rejection of Claims 12-14, 16, 19-36 and 38-39.

*Claims 4, 11, 18 and 37 Are Patentable Over Smith And Financial Advisor*

Regarding the rejection of Claims 4, 11, 18 and 37 under 35 U.S.C. § 103 as obvious over Smith in view of Financial Advisor, this rejection is respectfully traversed. First, these claims are dependent from one of the above-discussed independent Claims and are patentable over Smith in view of Financial Advisor for the same reasons previously discussed.

Further, Applicant submits that the Section 103 rejection of Claims 4, 11, 18 and 37 is improper. The Office cites “Financial Advisor” in rejecting these claims. However, in the Office Action, there is no corresponding publication associated with “Financial Advisor,” and so Applicant does not know what publication the Office is citing against these claims. Thus, the Office has not presented the relevant teachings relied up in rejecting the above claims. This is improper under MPEP 706.02(j)(A) where the Office is required to “set forth . . . the relevant teachings of the prior art relied upon.” Since an actual publication has not be presented to the Applicant in the Final Office Action, the Office has not met their prima facie case of obviousness burden.

In light of the above, it is submitted that Claims 4, 11, 18 and 37 are patentable over the cited art of record, and reconsideration and withdrawal of the 35 U.S.C. § 103 rejection of these claims is respectfully solicited.

*Claims 14, 22, 30, 36 and 39 Are Patentable Over Smith And Lange*

With regard to the rejection of Claims 14, 22, 30, 36 and 39 under 35 U.S.C. § 103 as obvious over Smith in view of U.S. Patent Application Publication No. 2002/0147670 to Lange (“Lange”), Applicant respectfully disagrees. As presented above, independent Claims 1, 12, 20, 28 and 34 are patentable over Smith. It is submitted that Lange adds nothing to the teachings of Smith to render independent Claims 1, 12, 20, 28 and 34 unpatentable. Accordingly, since Claims 14, 22, 30, 36 and 39 are each dependent from either independent Claim 1, 12, 20, 28 or 34, these claims are allowable for the same reasons each independent claim is allowable. Reconsideration and withdrawal of the 35 U.S.C. § 103 rejection of Claims 14, 22, 30, 36 and 39 is respectfully requested.

\* \* \* \* \*

**CONCLUSION**

In view of the amendments to the application and the foregoing remarks, it is respectfully submitted that all of the claims of the present application are in condition for immediate allowance.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 13-4365.